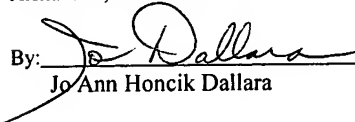


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PATENT
Atty. Docket No.: 021031-000113US

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By: 
Jo Ann Honcik Dallara

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McCombie, et al.

Application No.:

Filed: September 5, 2003

For: GENETICALLY FILTERED
SHOTGUN SEQUENCING OF
COMPLEX EUKARYOTIC GENOMES

Examiner:

Art Unit:

INFORMATION DISCLOSURE
STATEMENT UNDER 37 CFR §1.97 and
§1.98

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The references cited on the attached documents (see list of Enclosures at bottom) are being called to the attention of the Examiner. In accordance with 37 CFR §1.98(d), copies of the references can be found in Application No. 09/713,426, filed November 15, 2000 (Attorney Docket No. 021031-000110US). It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



Kenneth A. Weber
Reg. No. 31,677

TOWNSEND and TOWNSEND and CREW LLP
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San Francisco, California 94111-3834
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KAW:jhd

Enclosures: IDS of 8/23/01 w/ PTO/SB/08A citing refs. 1-22 (w/ Examiner initialed copy)
PTO-892 (Paper No. 5) citing refs. U-X
PTO-892 (Paper No. 8) citing refs. U-X (Page 1 of 2) and (Page 2 of 2) citing refs. U and V.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : McCombie, et al.
SERIAL NO : 09/713,426
FILED : November 15, 2000
TITLE : FILTERED SHOTGUN SEQUENCING OF COMPLEX EUKARYOTIC
GENOMES

Grp./A.U. : 1645
Conf. No. : 3370
Docket No. : P03842US2

**INFORMATION DISCLOSURE STATEMENT
FILED WITHIN THREE MONTHS OF FILING OR
BEFORE MAILING OF FIRST OFFICE ACTION (37 C.F.R. § 1.97(b))**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This information disclosure statement is being filed within three months of the filing date of the application or date of entry into the national stage of an international application or before the mailing date of a first Office Action on the merits, whichever event occurs last.

Attached are Forms PTO/SB/08A and 08B (formerly Form PTO-1449) listing the relevant art known to the applicant herein. The Examiner is requested to consider the references and make them of record. This application relies, under 35 U.S.C. § 120, on the earlier filing date of prior application Serial No. 09/430,409, filed on October 29, 1999. Each of the references listed on Forms PTO/SB08A and 08B were submitted to, and/or cited by, the Patent Office in the prior application(s) and, therefore, are not required to be provided in this application.

CERTIFICATE OF MAILING

I hereby certify that the above correspondence was mailed to the Assistant Commissioner for Patents, Washington, D.C. 20231, as First Class mail, postage prepaid, this 23rd day of August, 2001.

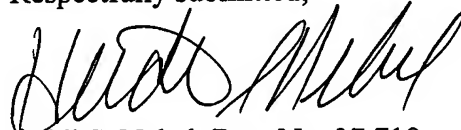

Heidi S. Nebel

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. § 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner.

Respectfully submitted,



Heidi S. Nebel, Reg. No. 37,719
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Phone No. (515) 288-3667
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CUSTOMER NO: 22885

- pw -

Attorneys of Record

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		<i>Complete If Known</i>	
		Application Number	09/713,426
		Filing Date	November 15, 2000
		First Named Inventor	McCOMBIE, W. Richard
		Group Art Unit	1645
		Examiner Name	
Sheet 1 of 2	Attorney Docket Number	P03842US2	

U.S. PATENT DOCUMENTS					
Examiner Initials *	Cite No. ¹	U.S. Patent Document Kind Code ² NUMBER <i>(if known)</i>	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	1	5,776,683	SMITH ET AL.	07/07/98	
	2	5,851,760	EVANS ET AL.	12/22/98	
	3	5,851,762	SIMONS, MALCOLM J.	12/22/98	
	4	5,871,917	DUFFY	02/16/99	

FOREIGN PATENT DOCUMENTS							
Examiner Initials *	Cite No. ¹	Foreign Patent Document Kind Code ⁵ Office ³ Number ⁴ <i>(if known)</i>		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
	5	WO	92/00385	PCT	Fox Chase Cancer Center	01/09/92	

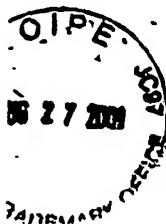
Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)				Complete if Known	
				Application Number	09/713,426
				Filing Date	November 15, 2000
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				Group Art Unit	1645
				Examiner Name	
Sheet <u>2</u> of <u>2</u>				Attorney Docket Number	P03842US2
OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS					
Examiner Initials *	Cite No. †	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²		
	1	Adams, Mark D., et al., "Complementary DNA sequencing: expressed sequence tags and human genome projects", <u>Science</u> , June 1991, Vol. 252:1651-1656			
	2	Adams, Mark D., et al., "Initial assessment of human gene diversity and expression patterns based upon 83 million nucleotides of cDNA sequence", <u>Nature</u> 377 (Supp):3-17 September 1995			
	3	Andersson et al., "A double Adaptor" method for improved Shotgun Library Construction. <u>Anal. Biochem.</u> 236:107-113 (1996)			
	4	Bird, Adrian, "Does DNA methylation control transposition of selfish elements in the germline", Institute of Cell and Molecular Biology, University of Edinburgh, Edinburgh, UK EH9 8JR (undated)			
	5	Borrebaeck, Carl A.K., "Tapping the potential of molecular libraries in functional genomics", <u>Immunology Today</u> , Nov. 1998 19(11):524-527			
	6	GIBCO BRL Catalog, 1997/1998, pages 18-1 and 18-5. Published by Life Technologies, Producer of GIBCO BRL Products, Corporate Headquarters, Gaithersburg, MD, USA			
	7	Gingrich et al., "Partial CviJI digestion as an alternative approach to generate cosmid sublibraries for large-scale sequencing projects", <u>Biotechniques</u> 21:99-104, July 1996			
	8	Grant, Seth G.N., et al., "Differential plasmid rescue from transgenic mouse DNAs into <i>Escherichia coli</i> methylation-restriction mutants", <u>Proc. Natl. Acad. Sci. USA</u> , June 1990, Vol. 87:4645-4649			
	9	Kochanek et al., DNA methylation in the Alu sequences of diploid and haploid primary human cells. <u>The EMBO J.</u> 12:1141-1151, 1993			
	10	Martienssen, R., "Transposons, DNA methylation and gene control", <u>Trends in Genetics</u> , July 1998, 14(7)			
	11	Paetkau et al., Microsatellites obtained using strand extension: an enrichment protocol., <u>Biotechniques</u> 26:690-697 (1996)			
	12	Putney, Scott D., et al., "A new troponin T and cDNA clones for 13 different muscle proteins, found by shotgun sequencing", <u>Nature</u> , April 1873, 302(21):718-721			
	13	Rabinowicz, Pablo D., et al., "Differential methylation of genes and retrotransposons facilitates shotgun sequencing of the maize genome", <u>Nature Genetics</u> , 23(3):305-308 (XP-002143094) 1999			
	14	Ramsay, Graham, "DNA chips: State-of-the-art", <u>Nature Biotechnology</u> , Jan. 1998, 16(1):40-44			
	15	Riley et al., A novel rapid method for the isolation of terminal sequences from yeast artificial chromosome (YAC) clones, <u>Nucleic Acids Res.</u> 18:2887-2890, 1990			
	16	SanMiguel, Phillip, et al., "Nested Retrotransposons in the Intergenic Regions of the Maize Genome", <u>Science</u> , 274:765-768 (XP000867133) 1996			
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	19	Venter, J. Craig, et al., "Shotgun sequencing of the human genome", <u>Science</u> , June 1998, Vol. 280:1540-1542			
	20	Weber, James L., et al., "Human whole-genome, shotgun sequencing", <u>Genome Research</u> , Vol. 7:401-409, Cold Spring Harbor Laboratory Press (1997)			
	21	Woodcock, D.M., et al., "rg1B facilitated cloning of highly methylated eukaryotic DNA: the human Lt transposon, plant DNA, and DNA methylated <i>in vitro</i> with human DNA methyltransferase", <u>Nucleic Acids Research</u> , 1998 16(10):4465-4483			
	22	Yoder, Jeffrey A., et al., "Cytosine methylation and the ecology of intragenomic parasites", <u>Trends in Genetics</u> , August 1997, 13(8)			
Examiner Signature		Date Considered			

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

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Sheet 1 of 2

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Application Number 09/713,426
Filing Date November 15, 2000
First Named Inventor McCOMBIE, W. Richard
Group Art Unit 1645 / 657
Examiner Name
Attorney Docket Number P03842US2

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U.S. PATENT DOCUMENTS

Examiner Initials *	Cite No. ¹	U.S. Patent Document Kind Code ² (if known)	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
u	1	5,776,683	SMITH ET AL.	07/07/98	
	2	5,851,760	EVANS ET AL.	12/22/98	
	3	5,851,762	SIMONS, MALCOLM J.	12/22/98	
u	4	5,871,917	DUFFY	02/16/99	

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u	5	WO 92/00385	PCT Fox Chase Cancer Center	01/09/92		

Examiner Signature	<i>Trille u</i>	Date Considered	11/26/2001
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¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

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Sheet 2 of 2

Complete if Known

Application Number	09/713,428
Filing Date	November 15, 2000
First Named Inventor	McCOMBIE, W. Richard
Group Art Unit	1645-127
Examiner Name	
Attorney Docket Number	P03842US2

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
u	1	Adams, Mark D., et al., "Complementary DNA sequencing: expressed sequence tags and human genome projects", <i>Science</i> , June 1991, Vol. 252:1651-1656	
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	5	Borrebaeck, Carl A.K., "Tapping the potential of molecular libraries in functional genomics", <i>Immunology Today</i> , Nov. 1998 19(11):524-527	
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	12	Putney, Scott D., et al., "A new troponin T and cDNA clones for 13 different muscle proteins, found by shotgun sequencing", <i>Nature</i> , April 1878, 302(21):718-721	
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	15	Riley et al., A novel rapid method for the isolation of terminal sequences from yeast artificial chromosome (YAC) clones, <i>Nucleic Acids Res.</i> 18:2887-2890, 1990	
	16	SanMiguel, Phillip, et al., "Nested Retrotransposons in the Intergenic Regions of the Maize Genome", <i>Science</i> , 274:765-768 (XP000867132) 1996	
	17	Sheldon et al., The construction of maize DNA libraries. <i>Maize Biol. Res.</i> 1982, 197-201. Editor(s): Sheridan, William F, Publisher Plant Mol. Biol. Assoc., Charlottesville, VA (abstract)	
	18	Stratagene Catalog (1994), page 206, Published by Stratagene Cloning Systems, 11011 North Torrey Pines Road, La Jolla, CA 92037	
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✓	22	Yoder, Jeffrey A., et al., "Cytosine methylation and the ecology of intragenomic parasites", <i>Trends in Genetics</i> , August 1997, 18(8)	
Examiner Signature	Full u		Date Considered
			11/16/01

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Notice of References Cited

Application/Control No.

09/713,426

Applicant(s)/Patent Under
Reexamination
MCCOMBIE ET AL.

Examiner

Frank W Lu

Art Unit

1655

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Saenz-Robles et al., Selection and characterization of sequences with high affinity for the engrailed protein of Drosophila. Mechanisms of Development, 53, 185-195, 1995.
	V	Andersson et al., A "double adaptor" method for improved shotgun library construction. Anal. Biochem., 236, 107-113, 1996.
	W	Sheldon, The construction of maize DNA libraries. Maize Biol. Res., 197-201, 1982.
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.06(a).)
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Notice of References Cited	Application/Control No. 09/713,426	Applicant(s)/Patent Under Reexamination MCCOMBIE ET AL.	
	Examiner Frank W Lu	Art Unit 1634	Page 1 of 2

U.S. PATENT DOCUMENTS

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	B	US-			
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	D	US-			
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	M	US-			

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	N					
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	P					
	Q					
	R					
	S					
	T					

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*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
*	U	Saenz-Robles et al., Selection and characterization of sequences with high affinity for the engrailed protein of Drosophila. Mechanisms of Development, 53, 185-195, 1995.
*	V	Andersson et al., A "double adaptor" method for improved shotgun library construction. Anal. Biochem., 236, 107-113, 1996.
*	W	Sheldon , The constriction of maize DNA libraries. Maize Biol. Res., 197-201, 1982.
	X	Gowher et al., DNA of Drosophila melanogaster contains 5-methylcytosine. The EMBO Journal, 19, 6918-6923.

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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	Examiner Frank W Lu	Art Unit 1634	Page 2 of 2

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	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

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	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Molecular Cell Biology (1990), pages 429-431, edited by Darnell et al., published by Scientific American Books, Inc.
	V	Magdesian et al., Cloning and characterization of a repetitive 1.9 kb Hind III DNA fragment from Crotalus durissus terrificus Genome. Comp. Biochem. Physiol. , 118B, 7-11, 1997.
	W	
	X	

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